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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,589	03/02/2004	Glenn Klecker	DBH:0756.0840	3452
152	7590	04/27/2009	EXAMINER	
CHERNOFF, VILHAUER, MCCLUNG & STENZEL			PRONE, JASON D	
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601 SW SECOND AVENUE				3724
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,589	<b>Applicant(s)</b> KLECKER ET AL.
	<b>Examiner</b> Jason Daniel Prone	<b>Art Unit</b> 3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 January 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-8,10,11,15-19,22,28-31,33 and 34 is/are pending in the application.
  - 4a) Of the above claim(s) 28-31 and 33 is/are withdrawn from consideration.
- 5) Claim(s) 2-4,8,11,15-19 and 34 is/are allowed.
- 6) Claim(s) 5-7,10 and 22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| <input type="checkbox"/> Notice of References Cited (PTO-892)                    | <input type="checkbox"/> Interview Summary (PTO-413)           |
| <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-548) | Paper No(s)/Mail Date _____                                    |
| <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Specification***

1. The amendment filed 1-26-09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: As disclosed by applicant, the original specification and claims do not disclose this newly added limitation; also, the Figures do not show a planar view of the entire spring actually showing the spring as a whole is substantially coplanar.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As disclosed by applicant, the original specification and claims do not disclose this newly added limitation; also, the Figures do not show a planar view of the entire spring actually showing the spring as a whole is substantially coplanar.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5 and 6, the phrase "rubber-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "rubber-like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). The application does not disclose what is meant by rubber-like. For example, chewing gum, wood sap, rubber, etc. are all rubber-like but not all rubber-like materials are appropriate for this apparatus. The phrase "a resiliently soft and rubber-like thermoplastic elastomeric material" should be replaced with "a resiliently soft thermoplastic elastomeric material". This statement inherently describes a rubber material.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al. (2004/0010924) in view of Thompson et al. (5,483,747) further in view of Shyr (2004/0000058) even further in view of Students (3,834,022). In regards to paragraphs

(a) and (c)-(e), Hung et al. disclose the invention (see rejection to claims 2-4, 8, and 15-19 in the previous Office action mailed 31 March 2008).

In regards to paragraph (b), the combination of Hung et al. in view of Thompson et al. discloses the invention (see rejection to claims 2-4 and 8 in the previous Office action mailed 31 March 2008). Therefore, one of ordinary skill in the art, at the time of the invention, to have provided Hung et al. with the blade assembly, as taught by Thompson et al., because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

In regards to paragraph (e), Hung et al. disclose the invention including a spring urging the jaw and the blade assembly to pivot apart from each other (30).

However, Hung et al. in view of Thompson et al. fail to disclose the jaw defining a cavity surrounding the blade pivot joint and a groove extending away from the cavity, the spring located in the cavity, the spring having a pair of ends, a first end extending into the groove and being engaged with the jaw, the other end extending outward from and beyond the cavity towards the second handle pivot joint and being engaged with the tang of the blade carrier, and the main part and both end of the spring being substantially coplanar.

Shyr teaches that it is old and well known in the art of shears to incorporate a groove (62), a spring (42), the spring having a pair of ends (421, 422), a first end extending into the groove and being engaged with the jaw (422), the other end

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extending outward from and beyond the cavity towards the second handle pivot joint and being engaged with the tang of the blade carrier (421), and the main part and both end of the spring being substantially coplanar (42). Therefore, one of ordinary skill in the art, at the time of the invention, to have provided Hung et al. in view of Thompson et al. with the spring, as taught by Shyr, because the substitution of one known element for another would have yielded predictable results and all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

However, Hung et al. in view of Thompson et al. further in view of Shyr fail to disclose a cavity and the spring having a main part located in the cavity.

Students teaches it is old and well known in the art of pivots points of shears to incorporate a cavity housing a main portion of the spring (Fig. 5). Therefore, one of ordinary skill in the art, at the time of the invention, to have provided Hung et al. in view of Thompson et al. further in view of Shyr with the spring cavity, as taught by Students, because the substitution of one known element for another would have yielded predictable results and all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective function and the combination would have yielded predictable results.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al. in view of in view of Shyr further in view of Students. With regards to paragraphs (a)-

(e), Hung et al. discloses the invention (see rejection to claims 15-19 in the previous Office action mailed 31 March 2008). With regards to paragraph (f), the combination of Hung et al. in view of Shyr further in view of Students disclose the invention (see rejection to claim 10 above).

***Allowable Subject Matter***

9. Claims 2-4, 8, 11, 15-19, and 34 are allowed. Upon the entire application being in condition for allowance, claims 28, 30, and 31 would be-rejoined and are allowable due to their dependence off of allowable claims.

10. Claims 5-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

11. Applicant's arguments filed 1-26-09 have been fully considered but they are not persuasive. The specification does not disclose what structure a rubber-like material incorporates. Basically, it is unclear what allows something to be considered rubber-like. Removing the term "rubber-like" in light of the newly added structural limitation would inherently disclose a substance with rubber properties. The ends of the spring and the main portion of the spring in Shyr may not be considered co-planar but they can be considered substantially co-planar. Also, dictionary.com defines groove as: A long narrow furrow or channel and defines channel as: a tubular passage. Therefore, item 62 can be considered a groove.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Daniel Prone whose telephone number is (571)272-4513. The examiner can normally be reached on M-F 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

24 April 2009

/Jason Daniel Prone/

Primary Examiner, Art Unit 3724